

REMARKS

The following remarks are fully and completely responsive to the Office Action dated August 12, 2004. Claims 1-35, 80-121, 137-231 are pending in this application with claims 54-79 and 122-136 cancelled and claims 200-231 added by the present amendment. In the outstanding Office Action, the priority claim was objected to as the specification failed to contain a specific reference to prior applications in the first sentence of the specification; the Information Disclosure Statement filed July 17, 2001 was objected to for failing to contain a legible copy of each reference; claims 22 and 23 were objected to; claims 1, 80 and 81 were rejected under 35 U.S.C. § 112, second paragraph; and claims 1-53, 80-121 and 137-199 were rejected under 35 U.S.C. § 102(b). Claims 1-53, 80-86, 88-101, 104-121, 137-147, 149-163, and 165-199 are subject to an obviousness-type double patenting rejection over claims 1-82 of U.S. Patent No. 6,542,858. Claims 1, 2, 6, 7, 11-14, 19-23, 31, 32, 36, 44, 80-83, 90, 91, 93, 100, 106, 110, 111, 113, 114, 116, 137-139, 151, 153-160, 169, 176, 182, 184, 188, 192, 194, 196, 198 and 199 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-45, 61-66, 85-92, 109-120, 132, 133, 168, 179, 189-196, 231-242, 255-266, and 323 of the U.S. Patent No. 6,647,358. No new matter has been added. Claims 1-53, 80-121, and 137-231 are presented for consideration.

Priority

The Office Action stated that the applicant has not complied with one or more conditions to receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). Specifically, the Office Action stated that the application failed to contain specific

reference to the prior applications in the first sentence of the application. Applicants' amendment to the specification includes this reference. Accordingly, Applicants request confirmation that this application now complies with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e).

Information Disclosure Statement

The Office Action asserted that the Information Disclosure Statement filed July 17, 2001 did not contain a legible copy of each reference listed on the list of references. Attached hereto are copies of the missing references along with a copy of the appropriate 1449 for initialing by the Examiner.

Claim Objections

Claims 22 and 23 were objected to because of the informalities listed in the Office Action. The amendments to claims 22 and 23 correct these informalities. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to claims 22 and 23.

35 U.S.C. § 112, Second Paragraph

Claims 1, 80 and 81 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 80 and 81 have been amended such that these claims now particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 80 and 81 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 102(b)

Claims 1, 53, 80-121 and 137-199 were rejected under 35 U.S.C. § 102(b) as being anticipated by Grass (reference "BW" in the Information Disclosure Statement filed July 17, 2001).

While Grass discloses a method of using a pharmacokinetic model to predict a pharmacokinetic property of a compound, Grass fails to disclose and/or suggest either the regional correlation parameter or the selected adjustment parameter, as appropriate, recited in the current claims.

Accordingly, Grass fails to teach and/or suggest each and every element of the claimed invention. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-53, 80-121 and 137-199 under 35 U.S.C. § 102(b).

Double Patenting

Claims 1-53, 80-86, 88-101, 104-121, 137-147, 149-163 and 165-199 were rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claims 1-82 of U.S. Patent No. 6,542,858. The enclosed Terminal Disclaimer renders this rejection moot.

Claims 1, 2, 6, 7, 11-14, 19-23, 31, 32, 36, 44, 80-83, 90, 91, 93, 100, 106, 110, 111, 113, 114, 116, 137-139, 141, 153-160, 169, 176, 182, 184, 188, 192, 194, 196, 198 and 199 were rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claims 37-45, 61-66, 85-92, 109-120, 132, 133, 168, 179, 186-196, 231-242, 255-266 and 323 of U.S. Patent No. 6,647,358. The enclosed Terminal Disclaimer renders this rejection moot.

New Claims

New claims 200-231 have been added to further claim Applicants' invention. These claims are allowable for at least the reasons discussed above. Accordingly, Applicants request consideration and allowance of new claims 200-231.

Conclusion

Applicants' amendments and remarks have overcome the objections and rejections set forth in the Office Action dated August 12, 2004. Specifically, the amendment to the specification overcomes the objection to the priority claim as not complying with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). The enclosed references overcome the objection to the Information Disclosure Statement filed July 17, 2001. The amendment to claims 22 and 23 overcomes the objection to these claims. The amendment of claims 1, 80 and 81 overcome the rejection of these claims under 35 U.S.C. § 112, second paragraph. Applicants' remarks have distinguished claims 1-53, 80-121 and 137-199 from Grass and thus overcome the rejection of these claims under 35 U.S.C. § 102(b). The two Terminal Disclaimers enclosed overcome the two double patenting rejections. Applicants' remarks have also distinguished new claims 200-231 from the cited prior art. Accordingly, claims 1-53, 80-121, and 137-231 are in condition for allowance. Therefore, Applicants respectfully request consideration and allowance of claims 1-53, 80-121, and 137-231.


Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants

respectfully request the Examiner contact the undersigned attorney by telephone if it is believed that such contact will expedite the prosecution of the application.

In the event that this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time.

Please charge any fee deficiency or credit any over-payment to Deposit Account No. 01-2300, referring to client/matter number 109904-00015.

Respectfully submitted



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Enclosures: Petition for Extension of Time
Terminal Disclaimers (2)
PTO Form 1449